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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of)
GABOR DEVENYI)
Ser. No. 10/084,704) GAU: 3682
Filed: February 26, 2002) Examiner:
For: LEADSCREW ASSEMBLY WITH A WIRE-WOUND) Colby Hansen
LEADSCREW AND A SPRING-PIN ENGAGEMENT)
OF A DRIVE NUT TO THE LEADSCREW)

RESPONSE TO OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This application has been reviewed in light of the Office Action of March 8, 2004. Claims 1-15 and 17-21 are pending, and all claims stand rejected. In response, the following remarks are submitted. Reconsideration of this application is requested.

Claims 1-7, 9, 10, 12-13, and 16 are rejected under 35 USC 103 over Beery US Patent 3,654,816 in view of Devenyi US Patent 5,636,549. Claim 16 has been canceled. Applicant traverses this ground of rejection as applied to the other rejected claims.

Claims 8 and 14 are rejected under 35 USC 103 over Beery in view of Devenyi '549 and further in view of Devenyi US Patent 5,533,417. Applicant traverses this ground of rejection.

Applicant incorporates its prior responses, and will devote this paper to a response to Examiner's arguments presented at pages 5-6 of the Office Action.

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- 2 -

1. Response to page 5, lines 6-19. The point of the remarks regarding the **unidirectional** nature of the movement of Beery's approach is that the attempt to combine the teachings of Devenyi with the teachings of Beery is to render the device of Beery inoperable, not to distinguish the recitations of the present claims. Beery absolutely requires an asymmetric rotating screw 16 to be functional. It would not function with a wire-wound thread as in Devenyi. The attempt to combine the teachings of Devenyi with those of Beery violates MPEP 2143.01 and MPEP 2143.02, as discussed in the prior Amendment. The question under MPEP 2143.01 is whether Beery would be rendered unsatisfactory for its intended purpose by the proposed combination, not whether some functional device could be hypothesized. There is no question that Beery's device would be rendered unsatisfactory by the proposed combination, because it would not have the asymmetric thread and resulting ratcheting characteristic that is a primary objective of Beery (col. 1, line 58-62). Nor would there be a reasonable expectation of success in the combination under MPEP 2143.02, because the ratcheting functionality of Beery's device would be lost, as would the bidirectional leadscrew functionality of Devenyi's device.

The further argument that it "could be deemed obvious to use the background art of Beery et al..." is similarly without basis. The whole point of Beery's approach is to produce an alternative to his stated background technology.

2. Response to page 5, line 20-page 6, line 4. There are three responses.

First, the proposed combination does take into account information other than that which was within the level of ordinary skill in the art, and it is based entirely upon knowledge gleaned from Applicant's disclosure. This attempted combination of teachings requires a decision as to the structure of the rotating screw in the modified form of Beery's device. Beery requires an asymmetric thread structure that could not be constructed with a round wound wire as in Devenyi. Devenyi's bidirectional device could not function with the asymmetric rotating screw of Beery. The determination to substitute Devenyi's wire-wound thread structure into the device of Beery, which renders the device of Beery inoperable, is based solely on an attempt to re-create in hindsight the present invention and is therefore based solely upon Applicant's

- 3 -

disclosure.

Second, In re McLaughlin is cited in a rote manner from the PTO's form set. In re McLaughlin is cited as support for the proposition that hindsight reconstruction is proper. Applicant traverses any assertion that this authority stands for any such position. When first enunciated over 30 years ago, the position of In re McLaughlin might have been subject to differing interpretations. Those seeking support for rejecting patent applications could argue that the quoted language means that no motivation to combine teachings need be found in the prior art, and those seeking to gain allowance would argue to the contrary.

After this case was propounded, its legal principles were later explained and clarified by the Court of Appeals for the Federal Circuit, the successor to the CCPA. As stated in In re Fine, 5 USPQ2d 1596, 1599 (Fed.Cir. 1988):

Obviousness is tested by 'what the combined teachings of the references would have suggested to those of ordinary skill in the art.' In re Keller, 208 USPQ 871, 881 (CCPA 1981). But it 'cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hosp. Sys. [cite omitted]. And 'teachings of references can be combined only if there is some suggestion or incentive to do so.' Id. Here, the prior art contains none." [emphasis in original]

The language quoted by the Federal Circuit, 'what the combined teachings of the references would have suggested to those of ordinary skill in the art,' is substantially that relied on in forming the rejection from In re McLaughlin, except taken from a 1981 decision that sets forth the same principles, In re Keller.

The Federal Circuit then goes on to explain that "teachings of references can be combined only if there is some suggestion or incentive to do so. Here, the prior art contains none." [First emphasis in original, second emphasis added.] The Federal Circuit has thus held that the prior art itself must contain some suggestion or incentive to combine the teachings of the references, by way of clarifying the interpretation of

- 4 -

cases like In re McLaughlin.

Third, the MPEP and case law requirements discussed in the prior Amendment are not met, and are not even addressed in the Response of the Office Action.

3. Response to page 6, lines 5-9. The claim limitations regarding rotation of the drive nut housing are not limited to specified locations and instances, as argued in the Office Action. The suggestion that the claim limitation is "broadly recited" so that it may be interpreted in some other manner than its straightforward language is incorrect. The claim limitation "a linear slide mechanism to which the drive nut housing is affixed so that the drive nut housing does not rotate" (quote from claim 12) is clear and does not suggest that it does not apply to some portion of the movement. Beery specifically requires that its housing be rotatable. The "most of the movement" argument does not successfully contravene the claim limitation, because there is no "most of the movement" type of limitation in the claim.

4. Response to page 6, line 10-14. The argument regarding assembly is pure hindsight. Beery describes his approach for assembly, which is unaffected by the presence or absence of an access opening. The argument of the rationale for the access opening presupposes that the assembly approach of Beery is to be changed, and there is no basis for that position. Like much of the rest of the rationale for combining the teachings of the references, the argument regarding the access opening is pure hindsight and is contrary to the express teachings of Beery.

5. Response to page 6, lines 15-21. The question is whether a person of ordinary skill in the art would have been motivated to make the proposed substitution in the face of all of the operability and practicality problems. The argument that "...the sensor is the only structure of Pan being used to modify Beery et al. (not its surrounding actuation structure)", as with much of the rest of the attempt to combine the teachings of the applied reference, is in itself a statement of a hindsight reconstruction. The selective use of only the helpful teachings of a reference, and not giving weight to the overall teachings of the reference, in this manner is a per se hindsight reconstruction. This approach is not proper. In In re Mercer, 185 USPQ 774, 778 (CCPA 1975), the CCPA stated:

- 5 -

"The relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention to one having ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention. See *In re Lunsford*, 53 CCPA 986, 357 F.2d 380, 148 USPQ 716 (1966)."

"The Board's approach amounts in substance, to nothing more than a hindsight 'reconstruction' of the claimed invention by relying on isolated teachings of the prior art without considering the over-all context within which those teachings are presented. Without the benefit of appellant's disclosure, a person having ordinary skill in the art would not know what portions of the disclosure of the reference to consider and what portions to disregard as irrelevant, or misleading. See *In re Wesslau*, 53 CCPA 746, 353 F.2d 238, 147 USPQ 391 (1965)."

In short, the selective use of only certain teachings of Beery, Devenyi, and Pan, while ignoring the contrary teachings, is pure hindsight reconstruction that relies only on Applicant's disclosure.

Applicant submits that the application is now in condition for allowance, and requests such allowance.

Respectfully submitted,



William Schubert

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